

COPY

Docket No.: F1866.0058

Application No. 09/804,570  
Response dated December 28, 2005  
After Final Office Action of October 5, 2005

### REMARKS

Claims 1-17 are pending in the present application. Claims 5-6, 9, 14 and 16-17 have been withdrawn from consideration. Claims 7-8, 13 and 15 have been rejected under 35 U.S.C § 112, second paragraph. Claims 1-4, 7, 8, 10-13 and 15 have been rejected under 35 U.S.C § 102(e) over Alberth *et al.* (U.S. Pat. No. 6,094,565). Reconsideration of the present application is respectfully requested in light of the below remarks.

As an initial matter, Applicant requests from Examiner to acknowledge receipt of the IDS filed on October 4, 2005, a copy of which is attached hereto.

Claims 7-8, 13 and 15 have been rejected under 35 U.S.C § 112, second paragraph. Applicant respectfully traverses this rejection.

In paragraph 2 of the Office Action, it is asked if "the tone controller cause[s] tone output from both the receiver and tone output unit at the same time when an incoming call arrived and/or depending on the detection of the hinge." Claims 7 and 13 recite that "the tone output controller causes tone output from the receiver at the time of the tone output from the call tone output unit." Claims 8 and 15 recite that "the tone output controller causes tone output from the call tone output unit at the time of the tone output from the receiver." Claims 7, 8, 13 and 15 are drawn to an embodiment of the present invention wherein tone is output simultaneously from the receiver and the tone output unit, irrespective of the position of the hinge. Applicant respectfully submits that the language in claims 7, 8, 13 and 15 is definite and need not be amended.

Similarly, claims 13 and 15 are dependent on claims 3 and 4 respectively. Claim 13 and 15 contain the same language, respectively, as claims 7 and 8 as discussed above. Applicant respectfully submits that the language of claims 13 and 15 is clear in

COPY

Application No. 09/804,570  
Response dated December 28, 2005  
After Final Office Action of October 5, 2005

Docket No.: F1866.0058

not being limited by the status of the hinge. Furthermore, none of the limitations in claims 3 and 4 prevent any dependent claim from causing tone output from the receiver and the tone output unit at the same time, regardless of the status of the hinge.

In response to Examiner's arguments on page 4 of the Office Action, Applicant respectfully submits that Figure 7 of the specification describes a preferred embodiment of the claimed invention. Claims 7, 8, 13 and 15 do not include the state of the hinge limitation of the preferred embodiment outlined in Figure 7. Limitations from the preferred embodiment cannot be read into claims 7, 8, 13 and 15. Again, Applicant respectfully submits that the language of these claims is definite as currently written.

Therefore, withdrawal of the rejection of claims 7, 8, 13 and 15 under §112, second paragraph is respectfully requested.

Claims 1-4, 7, 8, 10-13 and 15 have been rejected under 35 U.S.C § 102(b) over Alberth. Applicant respectfully traverses this rejection.

Claim 1, 2, 3 and 4 each explicitly recite that "upon a call arrival" a tone output controller causes tone output from either a call tone output unit or a receiver "when the hinge is unfolded from the folded state." (Emphasis added). Applicant respectfully submits that this feature of the present invention is neither taught nor suggested by Alberth.

On page 3 of the Office Action, it is argued that this feature is disclosed in column 5, lines 24-43 and column 7, lines 8-12 in Alberth. Applicant respectfully disagrees. The cited sections in Alberth merely disclose that "[i]f a call is incoming, the controller 304 activates the ringer 309, the vibrator 310, or the indicator 204 to alert a

COPY

Application No. 09/804,570  
Response dated December 28, 2005  
After Final Office Action of October 5, 2005

Docket No.: F1866.0058

user to the incoming call," and that "[i]f a call to the device 102 is incoming while the housing 105 is in the closed position 200, the controller 304 activates the ringer 309, the vibrator 310, or the indicator 204 to alert a user to the incoming call." However, Alberth is completely silent as to what action is taken "upon a call arrival" "when the hinge is unfolded from the folded state," as explicitly recited in Applicant's claims 1, 2, 3 and 4. (Emphasis added).

As discussed above, the cited portions of Alberth, namely column 5, lines 24-43 and column 7, lines 8-12, are completely silent with regards to what takes place "when the hinge is unfolded from the folded state" "upon a call arrival." Where Alberth discloses detecting the state of the hinge, the outcome of this detection is completely different from Applicant's claimed invention. For example, in column 7, lines 47-49, Alberth discloses answering the incoming call if the housing has been moved. Another example, in column 7, line 62 to column 8, line 10, Alberth discloses displaying the caller's identification information if the housing is moved while one of the side buttons is actuated. These outcomes are different from Applicant's claimed invention.

Therefore, withdrawal of the rejection of claims 1, 2, 3 and 4 over Alberth is respectfully requested.

Claims 7 and 8 are dependent on and include all of the limitations of claim 1. All of the arguments regarding claim 1 apply with equal force to claims 7 and 8. Therefore, withdrawal of the rejection of claims 7 and 8 over Alberth is respectfully requested.

Claim 13 and 15 are dependent on and include all of the limitations of claims 3 and 4 respectively. All of the arguments regarding claim 3 and 4 apply with equal

COPY

Application No. 09/804,570  
Response dated December 28, 2005  
After Final Office Action of October 5, 2005

Docket No.: F1866.0058

force to claims 13 and 15 respectively. Therefore, withdrawal of the rejection of claim 13 over Alberth is respectfully requested.

Independent claim 10 explicitly recites "outputting a reception tone from a receiver when a call arrives and the hinge is unfolded from the folded state." Independent claim 11 explicitly recites a tone output controller "that causes tone output from a receiver upon a call arrival when the two member bodies are unfolded from the folded state." (emphasis added). Applicant respectfully submits that the features recited in claims 10 and 11 are neither taught nor suggested by Alberth.

On page 3 of the Office Action, it is argued that these features are disclosed in column 5, lines 24-43 and column 7, lines 8-12 in Alberth. However, as discussed above, the cited section in Alberth merely discloses that "if a call to the device 102 is incoming while the housing 105 is in the closed position 200, the controller 304 activates the ringer 309, the vibrator 310, or the indicator 204 to alert a user to the incoming call." Controller 304 in Alberth does not output "a reception tone from a receiver when a call arrives and the hinge is unfolded from the folded state," as explicitly recited in Applicant's claim 10. (Emphasis added) Also, Controller 304 in Alberth does not cause "tone output from a receiver upon a call arrival when the two member bodies are unfolded from the folded state," as explicitly recited in Applicant's claim 11. (Emphasis added) Therefore, withdrawal of the rejection of claims 10 and 11 over Alberth is respectfully requested.

Claim 12 is dependent on and include all of the limitations of claim 11. Therefore, all of the arguments regarding claim 11 apply with equal force to claim 12. Therefore, withdrawal of the rejection of claim 12 over Alberth is respectfully requested.

COPY

Application No. 09/804,570  
Response dated December 28, 2005  
After Final Office Action of October 5, 2005

Docket No.: F1866.0058

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Dated: December 28, 2005

Respectfully submitted,

By

Michael J. Scheer

Registration No.: 34,425

DICKSTEIN SHAPIRO MORIN &  
OSHINSKY LLP1177 Avenue of the Americas  
41st FloorNew York, New York 10036-2714  
(212) 835-1400

Attorney for Applicant